

2013-1167
(Serial No. 10/378,261)

**United States Court of Appeals
for the Federal Circuit**

IN RE RAYMOND GIANNELLI

*Appeal from the United States Patent and Trademark Office,
Patent Trial and Appeal Board.*

BRIEF OF APPELLANT

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APRIL 25, 2013

CERTIFICATE OF INTEREST

Counsel for Appellant certifies the following:

1. The full name of every party represented by me is Raymond Giannelli
2. The name of the real party in interest represented by me is Cybex International, Inc.
3. All parent corporations and any publicly held companies that own 10 percent or more of the stock of the party or amicus curiae represented by me are: None
4. The names of all law firms and the partners or associates that appeared for the party or amicus now represented by me in the trial court or agency or are expected to appear in this court are:

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Dated: April 25, 2013

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STATEMENT OF RELATED CASES

No other appeal in or from the same proceeding was previously before this or any other appellate court whether under the same or a similar title, and there are no related cases pending before this Court or any other court.

STATEMENT OF JURISDICTION

- A. The statutory basis for jurisdiction of the U.S. Patent and Trademark Office Patent Trial Appeal Board (“Board”) is 35 U.S.C. §§ 6 and 134.
- B. The statutory basis for jurisdiction of this Court is 35 U.S.C. § 141.
- C. Appellant filed a timely Notice of Appeal on December 7, 2012 from the Board’s final and appealable Decision on Appeal issued October 29, 2012.

STATEMENT OF THE ISSUES

- 1. Did the Board misapply a legal standard peculiar to chemical compositions to a mechanical apparatus in which inherent properties cannot be established by indisputable facts but only by theorized possibilities or probabilities? *In Re Robertson*, 169 F.3d 743, 745 (Fed. Cir. 1999), *In Re Oelrich*, 666 F.2d 578 (C.C.P.A. 1981).
- 2. Can an odd or unintended use of a prior art mechanical device properly form the basis of a rejection for inherency? *Polaroid v. Eastman Kodak*, 789 F.2d 1556, 1573 (Fed.Cir. 1986), *Robertson, supra*.
- 3. Was it sufficient for the examiner or the Board to say, without explaining how or why, that there is “reason to believe” that the prior art ‘447 Giannelli machine is “inherently” “capable of being used ...” [to exert] “a pulling force in a rowing motion under this Court’s standards in *Robertson* and *Oelrich*, *supra*?

4. To the extent that the Patent Office's decision is reliant on 35 U.S.C. §103(a), did the Patent Office meet its burden of establishing a case of prima facie obviousness over the cited '447 reference where it failed to explain how or why a user could possibly use the cited '447 machine to perform a rowing motion? *In Re Leuders*, 111 F.3d 1569 (Fed. Cir. 1997).

STATEMENT OF THE CASE

Appellant filed U.S. Patent Application Serial No. 10/378,261 on March 3, 2003 (hereinafter the "Application" or the "'261 application") entitled ROWING MACHINE (A000011 – A000033).

The Examiner issued a first non-final action on October 12, 2005 rejecting the claims as anticipated under Section 102(b) by Appellant's own prior issued U.S. Patent No. 5,997,447 that is directed to a chest press machine. (A000061 – A000068).

Appellant filed a first response to the first action on April 12, 2006 amending the main independent claim 1 to clarify that the claimed machine worked via a *pulling force exerted by a user on the first handle portion in a rowing motion*. (A000072 – A000080).

The examiner issued a Final action re-asserting the same rejection as previously asserted on July 18, 2006. (A000081 – A000086).

Appellant filed a Notice Of Appeal on January 16, 2007 and his Appeal Brief on July 16, 2007. And, the examiner filed an Answer on February 5, 2008. (A000087 - A000128).

The Board of Appeals issued a final decision affirming the Examiner on October 29, 2012. (A0000153 – A0000159).

Appellant timely filed a Notice of Appeal to the Court of Appeals for the Federal Circuit on December 7, 2012 via Express Mail.

STATEMENT OF THE FACTS

A. Overview, Background and Claims of the Invention

The invention claimed in the ‘261 Application solved several deficiencies in prior row exercise machinery including providing a mechanical arrangement that defines a substantially linear path for the row motion pulling force exerted by the user and enables the user to stabilize themselves against being pulled forward by opposing that force through engagement with a chest pad. To that end claims 1, 14, 15 and 22 of the Application read as follows (underlined language added during prosecution, italicized language added for emphasis regarding structure):

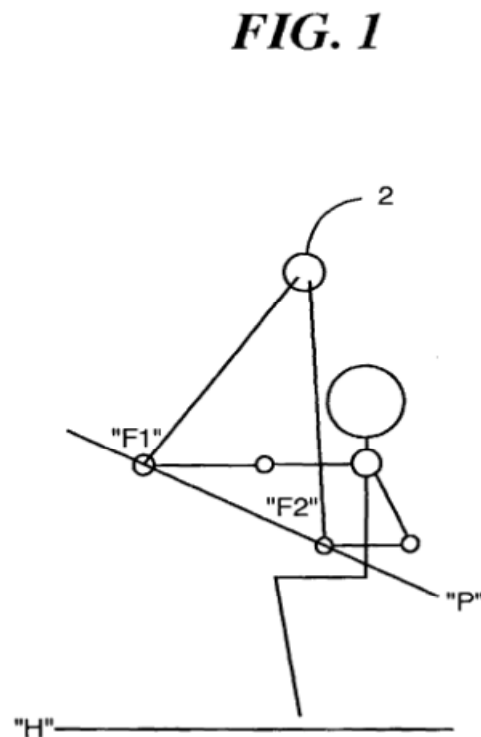
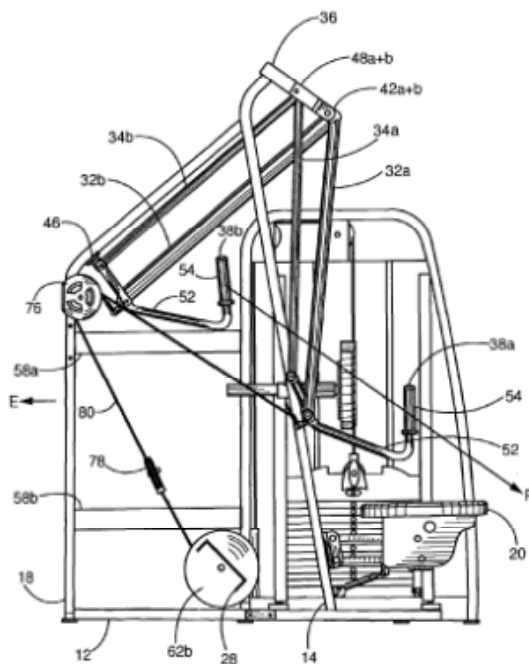
1. A row exercise machine comprising an input assembly including a first handle portion adapted to be moved from a first position to a second position by a pulling force exerted by a user on the first handle portion in a rowing motion, the input assembly defining a substantially linear path for the first handle portion from the first position to the second position.

14. The exercise machine according to claim 1, further comprising a user support structure including: a seat mounted to the frame; and a chest pad mounted to the frame above and in front of the seat.

15. A row exercise machine comprising: a frame; an input assembly pivotably mounted to the frame forward and above of a user, the input assembly including a first handle portion and a second handle portion and defining a substantially linear path for the first handle portion and the second handle portion from a first position to a second position by a pulling force exerted by a user on the first handle portion in a rowing motion; and a resistance mechanism operably connected to the input assembly.

22. The row exercise machine according to claim 15, further comprising a user support structure including: a seat mounted to the frame; and a chest pad mounted to the frame above and in front of the seat.

Figures 1, 4 illustrate these claimed features well:



B. The Patent Office's Rejection

On a first non-final action dated October 12, 2005 (A000061-A000064), the examiner rejected all of the claims based on a single conclusory statement without any explanation that all of claims 1-25 were anticipated by Applicant's own prior U.S. Patent No. 5,997,447 for a Chest Press apparatus (hereinafter the "447" or "447 patent") appearing at A000173-A000197, Fig. 5 of which is reproduced immediately below for illustrative context:

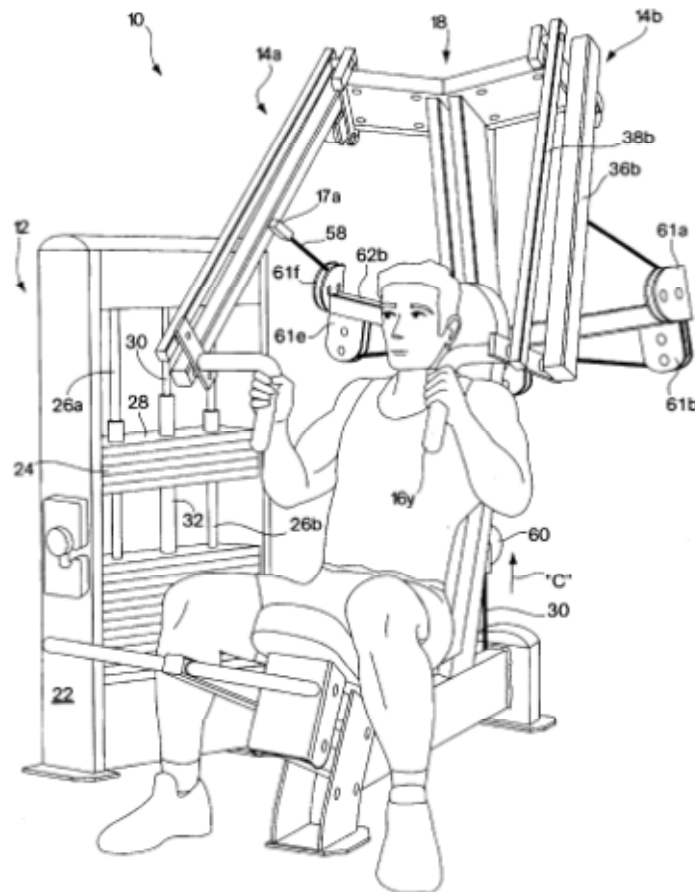


Fig. 5

The '447 patent describes and discloses a *chest press*, not a rowing machine.

Claim 1 of the '261 application, which the examiner and the Board later treated as

being representative of the entire set of claims 1-22 and 22-24, read as set out above. For purposes of clarity dependent claim 14, independent claim 15 and dependent claim 22 have also been noted in particular above.

In response to the examiner's first action, Applicant filed an amendment response (A000074-A000080) amending independent claims 1 and 15 by adding the language underlined above. The added language clearly distinguishes over the cited '447 patent specifying the first and second handle portions move *by a pulling force exerted by a user on the first handle portion in a rowing motion.*¹ The examiner then issued a final action on July 18, 2006 saying in a single conclusory sentence that the claims were not patentable because "the handle members of Giannelli ['447] are capable of being pulled by the user of the device. The user is not limited to be confined to his seat." (A000083).

On appeal, the PTO Appeal Board simply adopted the examiner's conclusions without any factual explanation of its own, saying:

- "... the device is also capable of being pulled by the user ..."

(A000003)

¹ As discussed in detail below the same allegedly functional claim language, namely, "pull ... in a rowing motion," appears in dozens of prior allowed and issued patents for exercise machines and is one of the points of novelty of each of these prior issued patents over the prior art. Several notable examples of such prior patents being U.S. Patent No. 5,273,505, U.S. Patent No. 5,135,456 and U.S. Patent No. 5,135,449 (A000198-A000228).

- “... the user is not limited to, or confined to, a seat ...” (A000003-A000004)
- “... the Patent and Trademark Office has reason to believe that a claimed functional limitation [pulling ... in a rowing motion] is an inherent characteristic of the prior art ...” (A000004)
- “... in our view ... a user could face the handles ... and exert a pulling force on the handles ... in a rowing motion ... (A000005)
- “... Giannelli’s support cushion 27 meets the claim limitation of a ‘chest pad’... “ (A000006)

There is no factual or expert explanation anywhere in any of the examiner’s office actions, the examiner’s appeal briefing or in the PTO Board of Appeals’ decision as to how or why a person skilled in the art could use or would use the prior Giannelli ‘447 chest press to *pull on the handles* in a rowing motion.

C. The Prior Giannelli ‘447 Chest Press – The Patent Office Theorizes About How The ‘447 Can *Possibly* Be Used In An Odd, Unexplained Manner In Which It Is Not Intended To Be Used

The patent office asserts that it has “good reason to believe” that the Giannelli ‘447 apparatus can be used as (a) rowing machine or (b) in a standing position to pull on the handles or (c) in a sitting position to pull on the handles. Taking the Patent Office’s hypothetical reasoning, if a user were to attempt to use the Giannelli chest press ‘447 apparatus in the manner that the Patent Office says it *could be* used, the following would result from such attempted uses.

The Board’s opinion holds that there is a burden on Appellant to show that the Patent Office’s ‘reason for believing’ that the product of the ‘447 patent is the

same as the claimed product is not true. Based on the clear Figures and written description of the '447 themselves, the Patent Office's 'reason for believing' is in error for at least the following reasons.

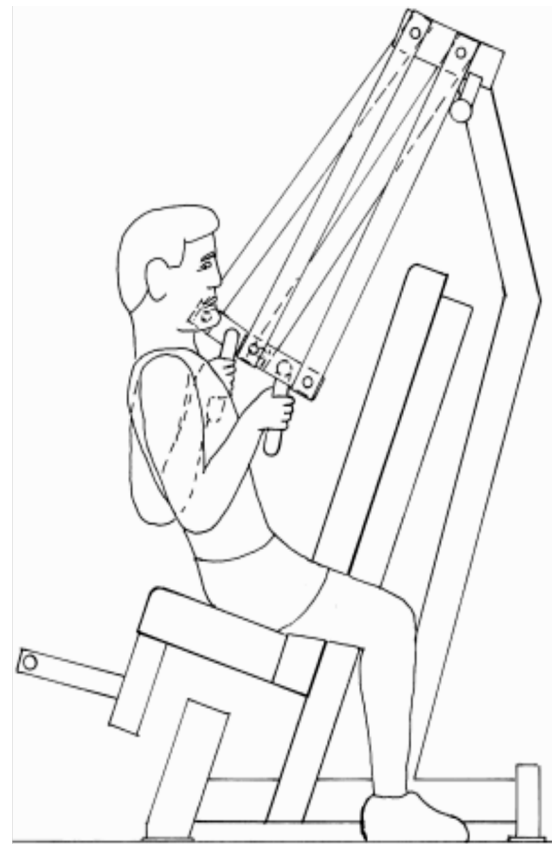
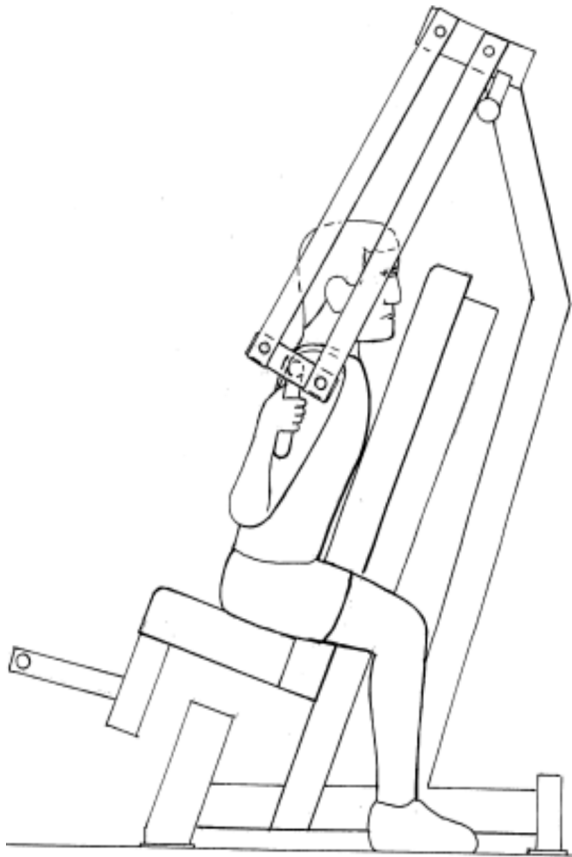
**User SITTING
Backwardly Facing A Back Rest Of A '447 Chest Press
Attempting To Perform PTO's Hypothetical Rowing Exercise**

At Start –

- User's Chest Against Back Rest
- User Not in a Rowing Position
- Hands Are Disposed *Behind* User's Shoulders
- *Impossible to Pull* Handles In Starting Position

Any Attempt To Move Handles -

- User Must Lean Backwards, Not *Pulling* In a Row Motion
- User's Chest Not Pulled Forward Against Pad As In Row Motion
- Handles Moving Up, Not In a Row Motion



These illustrations are as accurate a representation as any imaginable representation of the Patent Office's theoretical use of the '447 chest press in a backwards sitting position. The Patent Office never explains how "... the device is also capable of being pulled by the user ..." (A000003) in a rowing motion. On its face, it isn't capable. To the extent the Patent Office believes there is some *other possible* use of the '447 while sitting backwards on the seat, the Patent Office never explains how "in our view ... a user could face the handles ... and exert a pulling force on the handles ... in a rowing motion ..." (A000005).

Taking the Patent Office's own re-invention of the use of the '447 with the user sitting backwards facing the machine on an inclined seat as explicitly disclosed in the '447, a user cannot and is not reasonably capable of performing a rowing exercise according to the claim language of the '261 application. The claim language of claims 1 and 15 requires "a first handle portion adapted to be moved from a first position to a second position by a pulling force exerted by a user on the first handle portion in a rowing motion ..." Even further, dependent claims 14 and 22 require *a chest pad mounted to the frame above and in front of the seat.*

As shown above, in a sitting position a user cannot exert a pulling force in a rowing motion using the '447 apparatus because the user's hands are located *behind* the user's shoulders to begin the exercise with.

As shown above, the *back rest* of the '447 is *not* a chest pad and cannot be used as a chest pad by a user in a sitting position because the user has to lean forward to even engage the back rest in a sitting position. Even to a person not skilled in the art the back rest does not function as a chest pad.

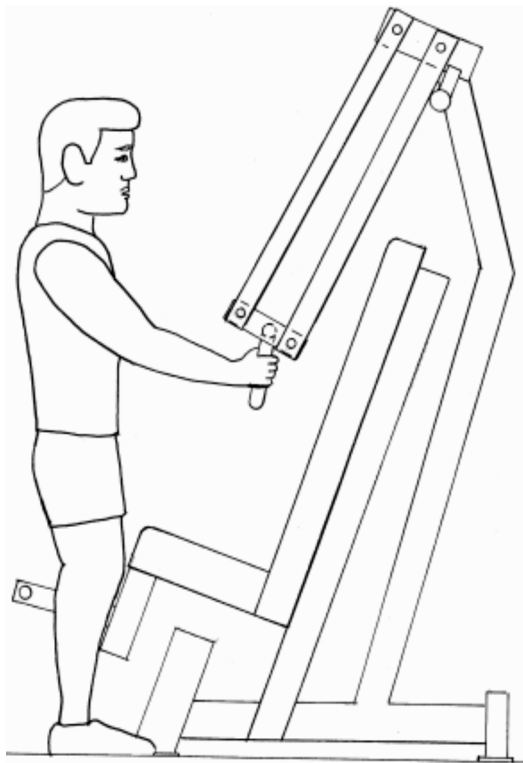
User STANDING UP
Backwardly Facing A Back Rest Of A '447 Chest Press
Attempting To Perform PTO's Hypothetical Rowing Exercise

At Start –

- User's Chest Not Against Pad
- User Not in a Rowing Position
- User Standing Without Front to Rear Support

Subsequent Attempt To Pull Handles -

- User Is Pulled Forward
- By Weight Connected To Handle, Cannot Move Handles
- User Holding Onto Handle to Avoid Falling Forward



The above illustration is as accurate a representation as any imaginable representation of the Patent Office’s theoretical use of the ‘447 chest press in a standing position. The Patent Office never explains how “... the device is also capable of being pulled by the user ...” (A000003). To the extent the Patent Office proposes some *other possible* use of the ‘447 in a backwards standing position, the Patent Office never explains what the Patent Office means by “... the user is not limited to, or confined to, a seat ...” (A000003-A000004) or by “in our view ... a user could face the handles ... and exert a pulling force on the handles ... in a rowing motion ...” (A000005).

Taking the Patent Office’s own re-invention of the use of the ‘447 with the user standing backwards facing the machine, a user cannot and is not reasonably capable of performing a rowing exercise according to the claim language of the ‘261 application. The claim language of claims 1 and 15 requires “a first handle portion adapted to be moved from a first position to a second position by a pulling force exerted by a user on the first handle portion in a rowing motion ...” Even further, dependent claims 14 and 22 require *a chest pad mounted to the frame above and in front of the seat.*

As shown above, in a backwards standing position a user cannot exert a pulling force in a rowing motion because the user cannot brace themselves against the force of the weights connected to the handles. The handles cannot be moved.

As shown above, the *back rest* of the ‘447 is *not* a chest pad and cannot be used as a chest pad by a user in a standing position because the user cannot lean forward far enough to even engage the back rest in a standing position. Even to a person not skilled in the art the back rest does not function as a chest pad.

D. Numerous *Exercise Machine* Patents Have Been Allowed And Issued By The Patent Office Using The Same Or Similar Allegedly Functional Language: “pull ... in a row motion ...”

The Patent Office has issued numerous patents using essentially the same claim language as the ‘261 application uses here which the Board cites as being not sufficient to distinguish over the ‘447 because it is *functional*. By way of example only, several such prior issued patents are:²

² These patents are being cited and it is requested that the Court take judicial notice of them because the Board for the first time in its October 29, 2012 Decision raised the issue of the claim language of the ‘261 application being insufficient to distinguish over the prior art because it is functional. HFederal Rule of Evidence 201H provides that a court may take judicial notice of a fact that is “not subject to reasonable dispute because it (1) is generally known within the trial court's territorial jurisdiction; or (2) can be accurately and readily determined from sources whose accuracy cannot reasonably be questioned.” HFed.R.Evid. 201(b)H. Upon request by a party, the Court is required to take judicial notice of such documents if supplied with the necessary information to enable it to do so. HFed.R.Evid. 201(c)(2)H.

- U.S. Patent No. 5,273,505 (A000198-A000208) – claiming a high *row exercise machine* comprising: “... a lever ... having ... a forward end ... adapted to be grasped and *pulled* ... against the *force* ... in a high *row motion* ...” (A000206)
- U.S. Patent No. 5,135,456 (A000209-A000218) – claiming a low *row exercise machine* comprising: “ ... a lever ... having a second end adapted to be ... *pulled* toward the seat in a low *row exercise motion* ...” (A000217)
- U.S. Patent No. 5,135,449 (A000219-A000228) – claiming a *rowing exercise machine* comprising: “... a pair of levers ... each lever having ... an upper end adapted to be grasped ... and then *pulled* ... in a *row motion* ...” (A000227)
- U.S. Patent No. 4,880,224 (A000229-A000233) – claiming a *rowing machine* comprising: “... cable means ... *pulled* by an exerciser *during a rowing stroke* ...” (A000233)
- U.S. Patent No. 7,766,802 (A000234-A000258) – claiming a *row exercise machine* comprising: “... a user engagement device being movable in a *mid-row pulling exercise movement path* ...” (A000253)

SUMMARY OF ARGUMENT

The Patent Office is erroneously applying a legal standard peculiar to chemical compositions to a mechanical apparatus in which *inherent* properties cannot be established by indisputable facts but only by theorized possibilities or probabilities *In Re Robertson*, 169 F.3d 743, 745 (Fed. Cir. 1999), *In Re Oelrich*, 666 F.2d 578 (C.C.P.A. 1981).

A rejection based on inherency cannot be based on an odd or unintended use of a prior art mechanical device. *Polaroid v. Eastman Kodak*, 789 F.2d 1556, 1573 (Fed.Cir. 1986), *Robertson, supra*.

The Patent Office cannot conclude without first explaining *how and why*, that there is “reason to believe” that the prior art ‘447 Giannelli machine is “inherently” “capable of being used ...” [to exert] “a pulling force in a rowing motion” under this Court’s standards per *Robertson* and *Oelrich, supra* and the standards cited by the Board in *In Re Best*, 562 F.2d 1252 (CCPA 1977), *In Re Swinehart*, 439 F.2d 210 (CCPA 1971) and *In re Spada*, 911 F.2d 705 (Fed. Cir. 1990).

It is self evident in the disclosure of the prior art ‘447 Giannelli patent that the apparatus described and depicted cannot inherently be used to perform the methods and does not inherently have the structure claimed in the subject patent application? *In Re Robertson*, 169 F.3d 743, 745 (Fed. Cir. 1999), *In Re Oelrich*, 666 F.2d 578 (C.C.P.A. 1981).

ARGUMENT

A. Standards Of Review

The Patent Office’s factual findings are reviewable under the APA for “substantial evidence” and determinations of obviousness, de novo. *In Re Kotzab*,

217 F.3d 1365, 1369 (Fed.Cir.2000), *In Re Hyatt*, 211 F.3d 1367, 1372 (Fed. Cir. 2000), 5 U.S.C. § 500, *et seq.*, *Dickinson v. Zurko*, 527 U.S. 150, 165 (1999).

The Patent Office cannot factually conclude that a use is inherent in the prior art unless it can show that the alleged possible use is *inevitable*. *In Re Oelrich*, 666 F.2d 578, 581 (C.C.P.A. 1981).

The Patent Office's factual interpretation of the prior art is reviewable for substantial evidence. *In Re Gartside*, 203 F.3d 1305 at 1316 (Fed. Cir. 2000).

Review of the Patent Office's interpretation of this Court's precedents and federal statutory provisions is *de novo*. *Mazzari v. Rogan*, 323 F.3d 1000, 1005 (Fed. Cir. 2003), *Astra v. Layman*, 71 F.3d 1578 (Fed. Cir. 1995).

B. The Patent Office's Rejection Is Based On A Theory About How The Prior '447 Chest Press Might *Possibly* Be Used In An *Odd* And *Unintended* Way

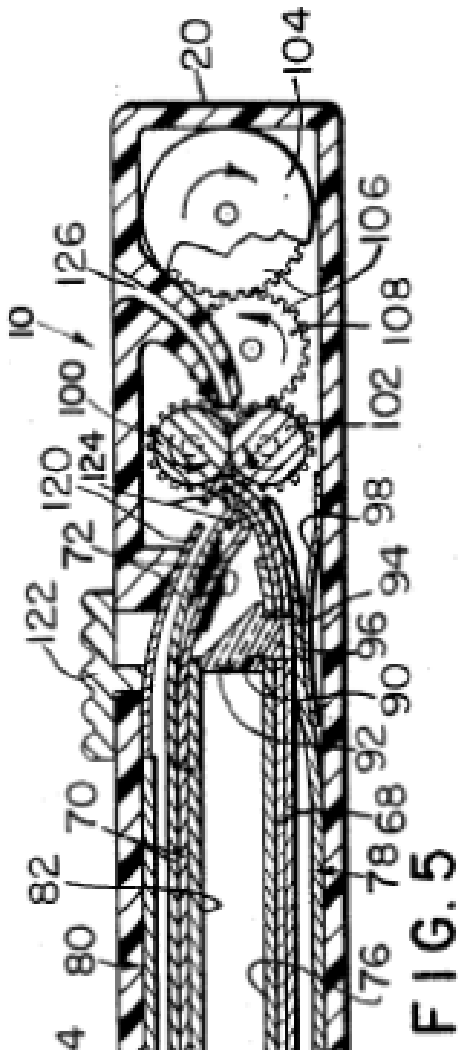
It is improper for the Patent Office to conclude that a function is inherent in the prior art where the purported function is an *odd* use of a device by which it was never intended to work. *In Re Robertson*, 169 F.3d 743 (Fed. Cir. 1999) (Patent Office theorizing about an *odd* use of the prior art improper). *Polaroid v. Kodak*, 789 F.2d 1556, 1573 (Fed.Cir. 1986) ("curved passage" of prior camera did not inherently possess claimed function because prior art not intended to be a light-shielding mechanism and not disclosed as so functioning).

**PRIOR ART DOES NOT ANTICIPATE
EVEN THOUGH CLAIMED FUNCTION IS PRESENT**

Polaroid v. Kodak, 789 F.2d at 1573

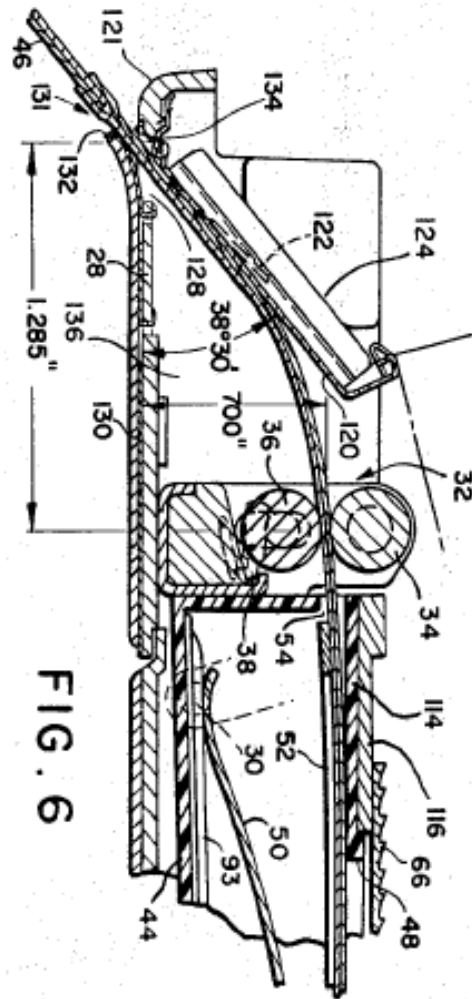
Prior Art

Deflecting Instant Film Exit 126
Not Intended To Function, But In Fact
Functions As Light Shield



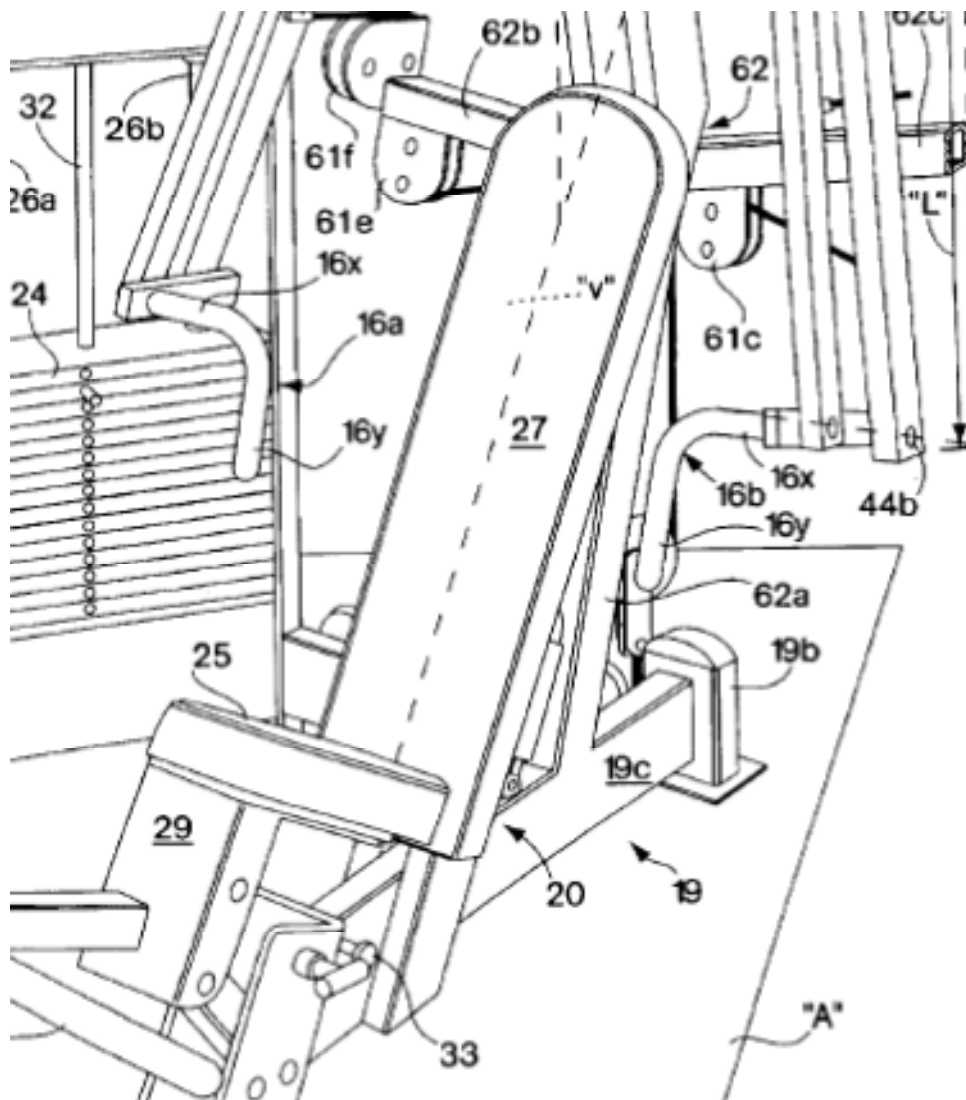
Claimed

Deflecting Instant Film Exit 131
Intended to Function, And
Functions As Light Shield



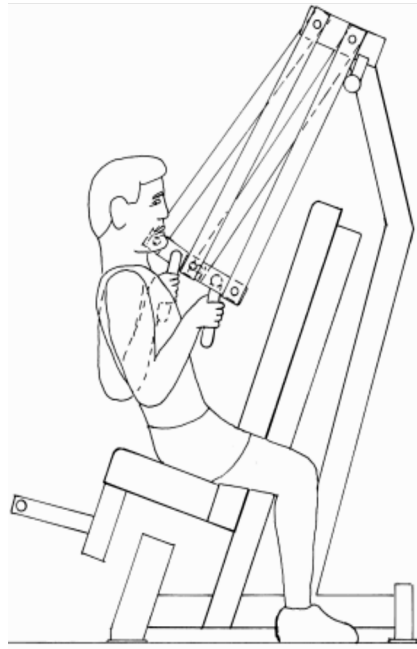
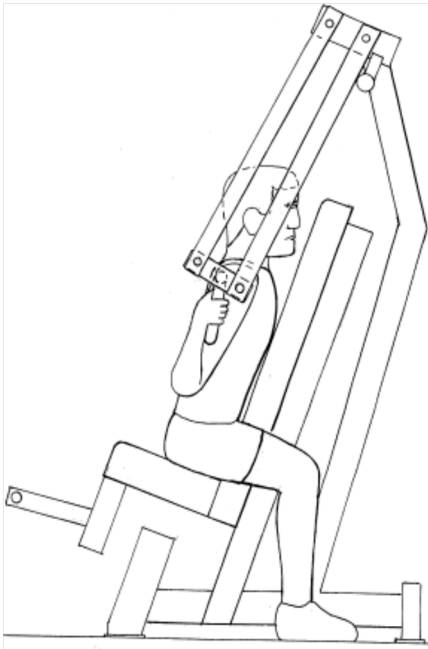
Here, the Patent Office contends that the user can position themselves *backwards* on Giannelli's own prior '447 chest press machine facing the seat and the back rest in a manner that is not only *not intended* but contrary to the purposeful teaching of

the ‘447. The ‘447 purposely teaches that: (a) the seat is *inclined*, (b) the back rest is *angled*, and (c) the user is required to sit *facing forwardly*, not backwardly in order to perform the intended chest press exercise, and not a pulling exercise as claimed in the ‘261 application. Immediately below is Fig. 1 which is an exemplary illustration of the arrangement of the seat, handles and back rest of the ‘447:

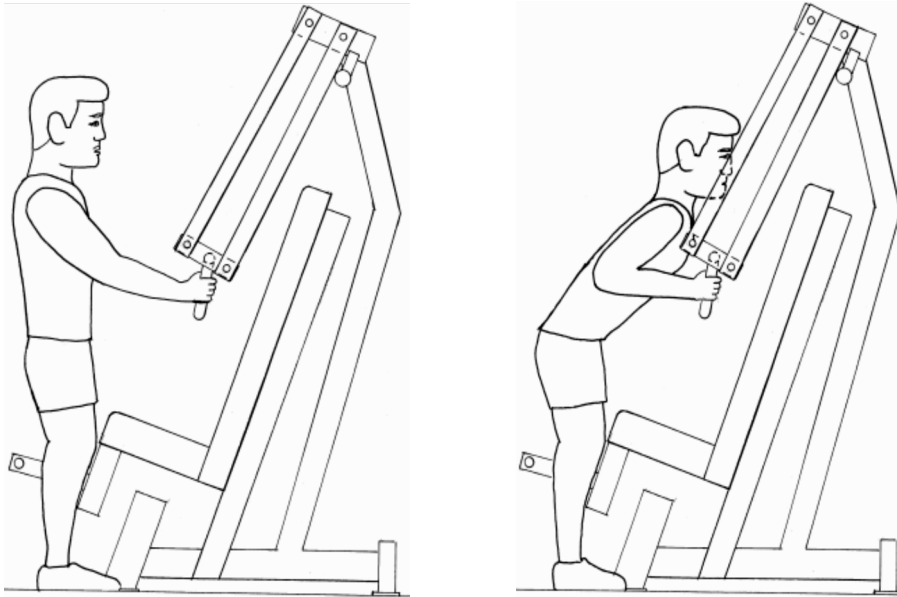


If a user were to attempt to use this structure in the manner that the Patent Office suggests, namely sitting backwards on the seat or standing backwards grabbing the handles which are perhaps the only reasonable position that a user could take facing backwards, the user would be positioned as illustrated immediately below and described above in Section A of the Statement of Facts:

**SITTING – IMPOSSIBLE TO PULL ON HANDLES AT START,
CANNOT USE BACK REST AS CHEST PAD, NO ROW MOTION**



**STANDING – UPPER BODY FALLS FORWARD, HANDLES DON'T MOVE
NO USE OF BACK REST AS CHEST PAD**



C. For A Use To Be Inherent In A Prior Art Machine, The Use Must Be Inevitable, Not A Possibility Or Probability

The Patent Office's contention that a user could sit or stand *backwards* facing the '447 and then pull on the handles and perform a rowing motion is never clearly articulated as to how or why a user could or would do such a thing. The Patent Office says nothing more than that "there is good reason to believe" that a user could use the '447 to exert a pulling force on the handle in a rowing motion.

This is not good enough. Where there are multiple *possible* ways in which a mechanical device could be used, the Patent Office cannot rely on mere unexplained theories to arrive at a conclusion of inherency. *In Re Oelrich*, 666 F.2d 578 (C.C.P.A. 1981) is as close to being on point to this case as there is. In *Oelrich* the Patent Office took the position as here that the Applicant's own prior

art patent disclosed a device that could inherently generate a frequency less than a minimum frequency. The appeals Court found that the Applicant's prior art device disclosed that it was adapted to generate a *higher* frequency, not a less than a minimum frequency. And even though it might be a *possibility* that the device could be used to generate a frequency less than a minimum frequency, this was not the *natural result* of the use of the device. Because the alleged inherent function was not an *inevitable* function, the Court reversed the Section 102 rejection.

Equally noteworthy is this Court's finding in *In Re Robertson*, 169 F.3d 743 (Fed. Cir. 1999) where the Patent Office was reversed on remarkably similar facts regarding a purported possible use of a device that was *less odd* than the Patent Office's hypothetical odd use of the '447 chest press apparatus:

"The Board's theory that these two fastening devices in Wilson were capable of being intermingled to perform the same function as the third and first fastening elements in claim 76 is insufficient to show that the latter device was inherent in Wilson. Indeed, the Board's analysis rests upon the very kind of probability or possibility-the odd use of fasteners with other than their mates-that this court has pointed out is insufficient to establish inherency." *id.* at 745

D. The Patent Office's Reliance For Inherency On *In Re Swinehart*, *In Re Spada*, *In Re Best* Is Misplaced, Chemical Compositions Are Not Analogous To Mechanical Devices Regarding Inherency

The patent office relies on these three cases for the proposition that “when the PTO shows sound basis for believing that the products of the applicant and the prior art are the same, the applicant has the burden of showing that they are not.” could be used to perform an alleged function recited in a claim of the subject application. None of these is applicable to this case. All three of these cases involve *chemical compositions* where the inherent property or use of the composition was in fact inevitable and unquestionable.

E. The Patent Office's Reliance On *In Re Schreiber* Is Misplaced

In re Schreiber is not analogous to this case. There was no dispute in Schreiber that the prior art reference cited by the Patent Office could be used for the same purpose as the claimed purpose. There was also no dispute that the structural limitations in the claim were also present in the prior art cited by the Patent Office. In particular in this case, there is no structure that is even remotely similar to a chest pad or something that could be arguably used as a chest pad. And, perhaps crucially, there was no *odd* hypothetical use of the prior art being asserted by the Patent Office. The prior art was a simple conical funnel, not a complex highly peculiarly designed chest press apparatus purposely designed for a specific exercise.

CONCLUSION

For the reasons stated, it is respectfully submitted that the Patent Office's Decision is erroneous and should be reversed.

Dated: April 25, 2013

Respectfully submitted,

/s/ Lawrence Oliverio

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ADDENDUM

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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte RAYMOND GIANNELLI

Appeal 2010-007582
Application 10/378,261
Technology Center 3700

Before JOHN C. KERINS, EDWARD A. BROWN, and
BENJAMIN D. M. WOOD, *Administrative Patent Judges*.

BROWN, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF THE CASE

Appellant appeals under 35 U.S.C. § 134(a) from the rejection of claims 1-25. (App. Br. 2). We have jurisdiction over this appeal under 35 U.S.C. § 6(b).

We AFFIRM.

THE CLAIMED SUBJECT MATTER

Independent claims 1, 15, and 23 are on appeal. Claim 1, reproduced below, is illustrative of the claimed subject matter:

1. A row exercise machine comprising an input assembly including a first handle portion adapted to be moved from a first position to a second position by a pulling force exerted by a user on the first handle portion in a rowing motion, the input assembly defining a substantially linear path for the first handle portion from the first position to the second position.

THE REJECTION

Claims 1-25 stand rejected under 35 U.S.C. § 103(a) as unpatentable over Giannelli (US 5,997,447; iss. Dec. 7, 1999).

ANALYSIS

Appellant argues claims 1 and 15 as a group, and does not provide separate argument for any one of dependent claims 2-14, 16-22, 24, and 25. (App. Br. 5-10; Reply Br. 2-3).¹ We select claim 1 as representative of the grouping, with claims 2-22, 24, and 25 standing or falling with claim 1. *See* 37 C.F.R. § 41.37(c)(1)(vii)(2011).

The Examiner found Giannelli discloses that its device is used in a pushing motion, but found that the device is also capable of being pulled by the user. (Ans. 3).² The Examiner also found that a user is not limited to, or

¹ We herein refer to the Reply Brief dated May 27, 2008.

² We herein refer to the Examiner's Answer mailed May 2, 2008.

confined to, a seat when using Giannelli's device. (*Id.*). The Examiner further found that the claimed "substantially linear path" of the handle portion encompasses the slightly curvilinear (path) disclosed by Giannelli. (Ans. 4).

Appellant contends that the claims are directed to a row exercise machine that requires a pulling force (App. Br. 5-6), whereas Giannelli is directed to a chest press machine, and "[a] chest press exercise machine and motion is a different field of structure and exercise from a row machine." (App. Br. 7). Appellant further contends that Giannelli discloses that "the user *pushes* the handles through a *curvilinear path* from a chest to shoulder high rest position to a fully extended outward or forward position. This is *opposite* the presently claimed invention." (App. Br. 9).

Regarding Appellant's contention that Giannelli is not directed to a row exercise machine, the relevant issue is whether Giannelli's apparatus is capable of being used by exerting a pulling force on the handles in a rowing motion. Where the Patent and Trademark Office has reason to believe that a claimed functional limitation is an inherent characteristic of the prior art, the burden is shifted to Appellant to show that the prior art does not possess that characteristic. *See In re Best*, 562 F.2d 1252, 1254-55 (CCPA 1977) (quoting *In re Swinehart*, 439 F.2d 210, 212-13 (CCPA 1971)); *see also In re Spada*, 911 F.2d 705, 708 (Fed. Cir. 1990) ("when the PTO shows sound basis for believing that the products of the applicant and the prior art are the same, the applicant has the burden of showing that they are not.") In response to the Examiner's findings as to how Giannelli's apparatus is capable of being used, Appellant contends that Giannelli does not teach or suggest that "a user should stand on their feet and pull the arms," and that:

The entire teaching of the Giannelli '447 disclosure is precisely the opposite of what the examiner contends that it is capable doing or how it is capable of being used. Even further, if a user were to stand on their feet and pull the handles, this would defeat the very purpose of the machine and the entire teaching of the disclosure.

(Reply Br. 2). These contentions are not persuasive.

Firstly, although Giannelli does not explicitly disclose the use of its structure as a row exercise machine, the absence of disclosure in Giannelli relating to this use or function is not dispositive. Rather, "[i]t is well settled that the recitation of a new intended use for an old product does not make a claim to that old product patentable." *See In re Schreiber*, 128 F.3d 1473, 1477 (Fed. Cir. 1997) (citation omitted).

Secondly, Appellant has not provided any persuasive argument or evidence to show that Giannelli's apparatus is incapable of being used by exerting a pulling force on the handles in a rowing motion. In our view, it is reasonable to find that a user could face the handles 16a, 16b and support cushion 27 of Giannelli's apparatus and exert a pulling force on the handles 16a, 16b in a rowing motion, where the force is exerted in a direction that extends away from the support cushion 27 so as to move the handles 16a, 16b from a first position to a second position. (*See also* Giannelli, col. 4, l. 66 – col. 5, l. 10 and col. 5, ll. 46-50). Although such use may not fully achieve the "purpose" of Giannelli's apparatus, Appellant has not shown that the apparatus could not be used in such manner.

Appellant also contends that the Examiner's "comment that a linear path cannot be sufficiently distinguished from a curvilinear path does not take into account any of the distinct structures or functions of the claimed

apparatus." (App. Br. 9). As noted *supra*, however, the Examiner found that the claims recite a "*substantially* linear path" (emphasis added). Appellant has not provided any persuasive argument or evidence as to why the claimed "*substantially* linear path" (emphasis added) should be construed to not encompass Giannelli's "*slightly* curvilinear path" (emphasis added). The term "substantially" allows for the first handle portion to travel in a path that deviates from a perfectly linear path. In addition, claim 1 does not recite any limitation as to how far the first handle portion must move "from the first position to the second position." It is reasonable to find that as this distance decreases for movement of the handles in Giannelli's apparatus, the path would increasingly correspond to a linear path.

Appellant also contends that Giannelli is non-analogous prior art. (App. Br. 9; Reply Br. 5). The two *separate* tests for determining whether a reference is analogous prior art for purposes of a rejection under 35 U.S.C. § 103 are: (1) whether the reference is from the same field of endeavor, regardless of the problem addressed; and (2) *if* the reference is not within the inventor's field of endeavor, whether the reference is reasonably pertinent to the particular problem with which the inventor is involved. *In re Bigio*, 381 F.3d 1320, 1325 (Fed. Cir. 2004). At the least, Appellant has not provided any persuasive argument as to why Giannelli does not meet test (1). The claimed invention is directed to the field of apparatuses for exercising the upper body. (Spec. para. [0003]). Giannelli is also directed to this same field of endeavor. (*See* Giannelli, col. 1, ll. 15-17). As such, we agree that Giannelli qualifies as analogous prior art.

In view of the above, we sustain the rejection of claim 1, as well as claims 2-22, 24, and 25.

Claim 23 is directed to a row exercise machine comprising, *inter alia*, a "user support structure mounted to the frame including a seat and a *chest pad*." (Emphasis added). The Examiner found Giannelli's support cushion 27 meets the claim limitation of a "chest pad." (Ans. 4). Appellant contends that "[t]he purpose of the chest [pad] is to oppose the *row-pulling motion* on the handles. No such component is present or even usable in the . . . Giannelli . . . apparatus." (App. Br. 7). This contention is not persuasive.

Claim 23 does not recite any structural limitation for the claimed "chest pad" that Giannelli's support cushion 27 lacks. In addition, the claim does not specify the location of the chest pad as opposing the row-pulling motion on the handles. Unclaimed features of the row exercise machine cannot be relied upon for patentability. *See In re Self*, 671 F.2d 1344, 1348 (Fed. Cir. 1982). As Appellant has not apprised us of any error in the Examiner's findings and conclusion, we sustain the rejection of claim 23.

DECISION

The Examiner's decision rejecting claims 1-25 is AFFIRMED.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a). *See* 37 C.F.R. § 1.136(a)(1)(iv).

AFFIRMED

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**United States Court of Appeals
for the Federal Circuit**
IN RE RAYMOND GIANNELLI, No. 2013-1167
CERTIFICATE OF SERVICE

I, Robyn Cocho, being duly sworn according to law and being over the age of 18, upon my oath depose and say that:

Counsel Press was retained by NOVAK, DRUCE, CONNOLLY, BOVE & QUIGG LLP, Attorneys for Appellant to print this document. I am an employee of Counsel Press.

On **April 25, 2013**, Counsel for Appellant has authorized me to electronically file the foregoing **Brief of Appellant** with the Clerk of Court using the CM/ECF System, which will serve via e-mail notice of such filing to any of the following counsel registered as CM/ECF users:

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Upon acceptance by the Court of the e-filed document, six paper copies will be filed with the Court, via Federal Express, within the time provided in the Court's rules.

April 25, 2013

/s/ Robyn Cocho
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Dated: April 25, 2013

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